

### **REMARKS**

The present Office Action addresses and rejects claims 1-7 and 28. Applicants respectfully request reconsideration in view of the remarks herein.

#### ***Amendments to the Claims***

Applicants amend independent claim 1 to correct a typographical error. No new matter is added.

#### ***Rejection Pursuant to 35 U.S.C. §112***

Claims 1-7 are rejected pursuant to 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants amend claim 1 to recite “a sheath...*for* cutting bone,” thereby obviating the basis for the rejection.

#### ***Rejections Pursuant to 35 U.S.C. §103***

##### **Simon in view of Hallac**

Claims 1 and 3-5 are rejected pursuant to 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,346,497 of Simon in view of U.S. Patent No. 3,605,721 of Hallac. Applicants respectfully disagree.

Claim 1 requires an apparatus for harvesting bone plugs having a tube with an inner bore and a sheath disposed around the tube having a tooth extending towards the inner bore for cutting bone to extract a bone plug. The Examiner refers to the guard (18) on the exterior tube (2) of Simon as being the claimed tooth. Simon teaches surgical cutting heads that have an inner tube with a cutting portion and an exterior tube (2) disposed around the inner tube. The guard (18) attached to the exterior tube (2) is meant to *protect against* cutting tissue. In particular, the guards taught in Simon are designed to have a “smooth outer surface” and to overhang the cutting edges of the inner tube to protect a patient against unintended cutting by the sharp cutting edges of the inner tube. *See col. 6, lines 1-15 of Simon.* The guard (18) of Simon is not capable cutting anything because it is designed to *prevent* the cutting of tissue. Thus it *cannot* be capable of cutting bone to extract a bone plug. In addition, Hallac does not

remedy the deficiency of Simon. Hallac is directed to a biopsy needle that does not have a tube with an inner bore and a sheath disposed around the tube having a tooth extending towards the inner bore for cutting bone. Accordingly, claim 1 as well as claims 3-5 which depend therefrom, distinguishes over Simon in view of Hallac and represents allowable subject matter.

Simon and Hallac in view of Stavropoulos

Claims 2, 6, and 28 are rejected pursuant to 35 U.S.C. 103(a) as being obvious over Simon in view of Hallac and in further view of U.S. Patent No. 4,142,517 of Stavropoulos et al. ("Stavropoulos").

Dependent Claims 2 and 6

The Examiner argues that Simon and Hallac disclose the invention substantially as claimed but fail to disclose various aspects of dependent claims 2 and 6. Thus, the Examiner relies on Stavropoulos to teach these various aspects. As noted above, claim 1, from which claims 2 and 6 depend, distinguishes over Simon in view of Hallac. Stavropoulos does not remedy their deficiencies. In particular, Stavropoulos is directed to a tube for extracting bone marrow and does not teach or suggest a tube with an inner bore and a sheath disposed around the tube having a tooth extending towards the inner bore for cutting bone. Accordingly, claims 2 and 6 distinguish over Simon in view of Hallac and in further view of Stavropoulos at least because they depend from an allowable base claim.

Independent Claim 28

Independent claim 28 requires an apparatus for harvesting bone plugs having a tube with an inner bore and a sheath disposed around the tube having a tooth extending towards the inner bore for cutting bone. As noted above with respect to claim 1, both Simon and Hallac fail to teach such a configuration. Simon only teaches a guard meant to protect against cutting and Hallac does not remedy this deficiency of Simon. Stavropoulos also fails to remedy this deficiency as Stavropoulos only teaches a tube for extracting bone marrow and does not teach or suggest a tube with an inner bore and a sheath disposed around the tube having a tooth extending towards the inner bore for cutting bone. Accordingly, claim 28 distinguishes over Simon in view of Hallac in further view of Stavropoulos.

Simon and Hallac in view of Torrie

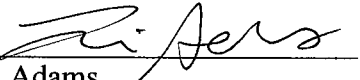
Claim 7 is rejected pursuant to 35 U.S.C. 103(a) as being obvious over Simon in view of Hallac and in further view of U.S. Patent No. 6,358,523 of Torrie et al. ("Torrie"). The Examiner argues that Simon and Hallac disclose the invention substantially as claimed but fail to teach a bone plug from articular cartilage and underlying bone tissue as required by claim 7. Thus, the Examiner relies on Torrie to teach such a bone plug. Torrie is directed to a method for repairing cartilage and does not teach or suggest a sheath disposed around a tube with an inner bore and having a tooth for cutting bone extending toward the inner bore, as required by claim 1 from which claim 7 depends. Accordingly, claim 7 distinguishes over Simon in view of Hallac and in further view of Torrie at least because it depends from an allowable base claim.

***Conclusion***

Applicants submit that all claims are in condition for allowance, and allowance thereof is respectfully requested. Amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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